

JUL 31 2006

REMARKS**I. Introduction**

With the cancellation herein without prejudice of claims 6, 7 and 8, claim 5 is pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that the presently pending claim is allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgement of their claim for foreign priority and the indication that all certified copies of the priority documents have been received in this National Stage application from the International Bureau.

II. Rejection of Claims 5 to 8 Under 35 U.S.C. § 103(a)

Claims 5 to 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,468,933 ("Eller") or U.S. Patent No. 6,064,039 ("Kumada"), and U.S. Patent No. 4,603,667 ("Gruenwald et al."). It is respectfully submitted that the combination of Eller or Kumada and Gruenwald et al. does not render unpatentable the present claims for at least the following reasons.

As an initial matter, claims 6 to 8 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 6 to 8.

Claim 5 relates to a sheathed-element glow plug for an internal combustion engine, comprising a housing, a glow tube situated on the housing and having a heating filament and a control filament situated in the glow tube, current being applicable to the heating and regulating filament via a terminal stud situated in the housing, wherein the at least one of the control filament and the heating filament is a multiple-coil filament.

Claim 5 has been amended herein without prejudice to incorporate the features of now-canceled claims 6 and 8. In particular, claim 5 as amended recites that a winding diameter of a first filament of the filaments has a smallest diameter and other of the filaments having individual filament diameters have larger winding diameters, and that the filaments having the individual filament diameters are wound in opposite directions

To reject a claim as obvious under 35 U.S.C. § 103(a), the prior art must disclose or suggest each claim feature, and the prior art must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

As an initial matter, neither Eller, nor Kumada, nor Grünwald et al. disclose, or even suggest, heating or control filaments, which are wound in opposite directions.

In addition, the statement on page 3, lines 3 to 9 of the Office Action, that it would have been obvious for one skilled in the art to wind the heating filament coils of Grünwald et al. in opposite directions, on the basis that Applicants have not disclosed that this particular winding arrangement solves any stated problem or is for any particular purpose and it appears that the heating filament of Grünwald et al. would perform equally well with such an arrangement, is untenable for the following reasons.

First of all, Applicants do disclose a purpose of, and a problem solved by, the oppositely-directed filament windings of claim 5 as amended. One purpose of this winding arrangement is to reduce the outer diameter of the overall filament. This winding arrangement also solves the problem of otherwise having to modify existing glow tubes to accommodate the filament (see page 3, lines 14 to 18 of the Substitute Specification). And even if the oppositely-directed winding arrangement of claim 5 as amended were not to solve any stated problem or were not for any particular purpose, which is not conceded for the purposes of this response, the above, in itself, would not be a sufficient motivation to modify Gruenwald to contain the oppositely-directed winding arrangement, as the motivation must be obtained from the references or the knowledge of one skilled in the art, *not from the present application.*

Secondly, the remark that it appears that the heating filament of Gruenwald et al. would perform equally well with the oppositely-directed winding arrangement of claim 5 as amended is apparently a statement of the Examiner's personal knowledge, and Applicants respectfully request that the facts underlying this statement be supported by an affidavit from the Examiner. And even if the above statement were true, which is not conceded, that the oppositely-directed winding arrangement of claim 5 as amended may be physically combinable with the device of Gruenwald et al. and would produce an operable device is not, in itself, a sufficient motivation to use this arrangement in Gruenwald et al. As stated above, the motivation must be present in the references themselves or in the knowledge of one skilled in the art.

Accordingly, it is respectfully submitted that the combination of Eller or Kumada, and Gruenwald et al. does not render unpatentable claim 5 as amended.


In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that the presently pending claim is allowable. It is therefore respectfully requested that the rejection be withdrawn, since it has been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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